

## REMARKS

Claim 11 has been amended to correct a typographical error.

### **I. Response to Claim Rejections under 35 U.S.C. § 102 and §103**

#### **A. Uytterhoeven et al.**

Claims 1-2 and 18-20 were rejected under 35 U.S.C. § 102 (b) or § 103 (a) as being unpatentable over Uytterhoeven et al.

Applicants respectfully submit that Uytterhoeven et al. does not disclose the photothermographic material of the claimed invention. In Uytterhoeven et al., the silver halide is formed by partial conversion of the organic silver salt to the silver halide, as described in column 14, lines 9-21 of Uytterhoeven et al. In contrast, in the present invention, the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed. This difference in the method of forming a mixture of the silver halide and the organic silver salt actually results in a materially different photothermographic material, as explained in the enclosed Declaration.

Specifically, in the photosensitive layer of the photothermographic of Uytterhoeven et al., the silver halide is located only on the organic silver salt crystals since the silver halide is generated by partial conversion of the

organic silver salt crystals. This corresponds to Method C, shown in the Declaration. As seen in FIG. 3 of the Declaration, black spots, which are AgX grains, are located on the organic silver salt crystals.

In the photosensitive layer of the photothermographic material of the present invention, the silver halide grains and the organic silver salt particles are dispersed separately, corresponding to process B of the Declaration. Consequently, a materially different product is formed as shown in Declaration FIG. 2. Here, the organic silver salt and AgX particles are well-dispersed as seen by the black spots of AgX and the dark gray regions of organic silver salt. The differences between photothermographic materials prepared by the conversion method and photothermographic materials prepared by the method of the present invention are further clarified in Tables 2 and 8-10 of the present specification.

Because Uytterhoeven et al. does not teach nor suggest the materially different, well-dispersed photothermographic material of the present invention, the withdrawal of this rejection is respectfully requested.

**B. Ohzeki et al.**

Claims 1-7 and 10-20 were rejected under 35 U.S.C. § 102 (e) or § 103 (a) as being unpatentable over Ohzeki et al.

Applicants respectfully submit that Ohzeki et al. does not disclose the photothermographic material of the claimed invention. In Ohzeki et al., the silver halide and the organic silver salts are prepared separately, then mixed, as described in paragraph [0411] of Ohzeki et al. This corresponds to method A of the Declaration. Specifically, in the photosensitive layer of the photothermographic material of Ohzeki et al., the silver halide grains and the organic silver salt particles combine to form large aggregates when they are mixed in an organic solvent as seen in Declaration FIG. 1. This is because the silver halide grains are not stable in a hydrophobic solvent. In contrast, the silver halide grains and the organic silver salt particles of the present invention are well-dispersed. This is because both the silver halide grains and the alkali metal soap (organic silver salt) are stable in an aqueous solvent.

Because Ohzeki et al. does not teach nor suggest the materially different photothermographic material of the present invention, the withdrawal of the rejection is respectfully requested.

**C. Fukui et al.**

Claims 1-20 were rejected under 35 U.S.C. § 102 (e) or § 103 (a) as being unpatentable over Fukui et al.

Applicants respectfully submit that Fukui et al. does not disclose the photothermographic material of the claimed invention. In Fukui et al., the silver halide and the organic silver salts are prepared separately, then mixed, as described in paragraph [0614] of Fukui et al. This corresponds to method A of the Declaration. In the present invention, the non-photosensitive organic silver salt is prepared in the presence of the photosensitive silver halide which has been preformed, i.e., method B of the Declaration. This difference in the method of forming a mixture of the silver halide and the organic silver salt results in a materially different photothermographic material being formed, as explained above.

Because Fukui et al. does not teach nor suggest the photothermographic material of the present invention, the withdrawal of the rejection is respectfully requested.

**D. Yoshioka**

Claims 1-20 were rejected under 35 U.S.C. § 102 (e) or § 103 (a) as being unpatentable over Yoshioka.

Applicants respectfully submit that Yoshioka does not disclose the photothermographic material of the claimed invention. In Yoshioka, the silver halide and the organic silver salts are prepared separately, then mixed,

as described in paragraph [0424] of Yoshioka and corresponding to method A of the Declaration. In contrast, method B is used in the present invention, resulting in a materially different product, as set forth above.

Because Yoshioka does not teach nor suggest the photothermographic material of the present invention, the withdrawal of the rejection is respectfully requested.

## **II. Response to Claim Rejections Under 35 U.S.C. § 103**

### **A. Uytterhoeven et al. in view of Ikienoue et al.**

Claims 3-6 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Uytterhoeven et al. and Ikienoue et al.

Applicants respectfully submit that the combination of Uytterhoeven et al. and Ikienoue et al. does not teach nor suggest the photothermographic material of the claimed invention.

The photothermographic disclosed in Uytterhoeven et al. is structurally different from the photothermographic material of the presently claimed invention, as explained above. The structure of the photothermographic material of the presently claimed invention can be obtained only when the photothermographic material is prepared by the

method of the present invention. Ikenoue et al. does not cure the deficiency of Uytterhoeven et al., since Ikenoue et al. also employs the conversion method for preparing a mixture of the silver halide and the organic silver salt, as described in column 18, lines 3-9 of Ikenoue et al.

Since the combination of Uytterhoeven et al. and Ikenoue et al. does not teach or suggest the photothermographic material of the claimed invention, the withdrawal of the rejection is respectfully requested.

**B. Uytterhoeven et al. in view of Arai et al.**

Claims 10-17 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Uytterhoeven et al. and Arai et al.

Applicants respectfully submit that the combination of Uytterhoeven et al. and Arai et al. does not teach or suggest the photothermographic material of the claimed invention.

The photothermographic disclosed in Uytterhoeven et al. is structurally different from the photothermographic material of the presently claimed invention, as explained above. Arai et al. cannot cure the deficiency of Uytterhoeven et al., since Arai et al. also employs the conversion method for preparing a mixture of the silver halide and the organic silver salt, as described in column 46, lines 50-52 of Arai et al.

Since the combination of Uytterhoeven et al. and Arai et al. does not teach nor suggest the photothermographic material of the claimed invention, the withdrawal of the rejection is respectfully requested.

**C. Uytterhoeven et al. in view of Goto et al. or Farid et al.**

Claims 8-9 were rejected under 35 U.S.C. § 103 as being unpatentable over the combination of Uytterhoeven et al. and Goto et al. or Farid et al.

Applicant respectfully submits that neither the combination of Uytterhoeven et al. and Goto et al. nor the combination of Uytterhoeven et al. and Farid et al. teaches nor suggests the photothermographic material of the claimed invention.

The photothermographic disclosed in Uytterhoeven et al. is structurally different from the photothermographic material of the presently claimed invention, as explained above. Goto et al. cannot cure the deficiency of Uytterhoeven et al., since in Goto et al. the organic silver salt and the silver halide are prepared separately, then mixed, as described in column 81, line 9-column 82, line 39 of Goto et al. Farid et al. cannot cure the deficiency of Uytterhoeven et al., since Farid et al. does not teach or suggest the method of the present invention.

Since neither the combination of Uytterhoeven et al. and Goto et al.

nor the combination of Uytterhoeven et al. and Farid et al. teaches nor suggests the photothermographic material of the claimed invention, the withdrawal of the rejection is respectfully requested.

## **II. Response to Nonstatutory Provisional Double Patenting**

### **Rejections**

#### **A. Application No. 10/238,611**

Claims 1-7 and 10-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 10/238,611 (US 2003/0194659). This reference is the same as Ohzeki. Applicant respectfully submits that Ohzeki does not teach nor suggest the photothermographic material of the claimed invention, for the reasons as described above. Accordingly, the withdrawal of the rejection is respectfully requested.

#### **B. Application No. 10/403,006**

Claims 1-7 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/403,006 (US 2003/0207216).



This reference is the same as Fukui. Applicant respectfully submits that Fukui does not teach nor suggest the photothermographic material of the claimed invention, for the reasons as described above. Accordingly, the withdrawal of the rejection is respectfully requested.

In view of the foregoing amendments and remarks, it is submitted that all of the claims currently pending in the application are in condition for allowance. Early and favorable action is respectfully requested.

Respectfully submitted,



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